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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,682	02/07/2001	Yuji Isoda	Q61219	3337
7590 10/14/2003				
SUGHRUE, MION, ZINN MACPEAK & SEAS, PLLC 2100 Pennsylvania Avenue, N.W. Washington, DC 20037-3202			EXAMINER LEE, SHUN K	
			ART UNIT 2878	PAPER NUMBER

DATE MAILED: 10/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/777,682

Applicant(s)

ISODA, YUJI

Examiner

Shun Lee

Art Unit

2878

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

THE REPLY FILED 25 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY (check either a) or b))

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): 1,2,4,6.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 1,2,4 and 6-16

Claim(s) objected to: _____

Claim(s) rejected: 25-28Claim(s) withdrawn from consideration: 5,17-24

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

CONSTANTINE HANNAHER
PRIMARY EXAMINER
GROUP ART UNIT 2878

Constantine Hannaher
HANNAHER

Continuation of 5. does NOT place the application in condition for allowance because: applicant argues that Herron et al. disclose using gold as the electrode, which is known to have a better conductivity, and which therefore teaches away from using indium. Examiner respectfully disagrees. As discussed in the previous office action, applicant has failed to provide any evidence within the cited references that Herron et al. teaches that only Au electrodes are to be used since Au electrodes have a higher conductivity than indium electrodes and thus teaches away from the use of indium electrodes. Applicant should note that gold (or Au) electrode could not be found anywhere within the disclosure of Herron et al. In addition, Herron et al. state (column 6, lines 33-40) that "Where the photoconductive element is a self-supporting film, the film may be metallized on one side by, for example, aluminum, silver, copper, nickel, and the like to provide an electrically conductive layer for contacting an electrically conductive surface during charging. Alternatively, an electrically conductive surface may be provided by laminating the metallized films to provide a metal foil". Thus, Herron et al. disclose a metal electrode with examples of aluminum electrode, silver electrode, copper electrode, and nickel electrode. If as argued by applicant a better conductivity gold electrode teaches away from the use of any metal electrode with a low conductivity, than the cited reference should state that only gold electrode can be used. However this is clearly not the case since Herron et al. explicitly state that any metal electrode can be used with examples of aluminum electrode, silver electrode, copper electrode, and nickel electrode and did not mention even as an example, a gold electrode. Thus it is clear that Herron et al. disclose that any metal electrode can be used including any metals not explicitly listed such as gold or indium regardless of the relative electrical conductivities. Therefore, applicant's arguments are not persuasive.